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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,611	04/30/2001	Peter Kassan	P/1318-129	2623

2352 7590 04/20/2005

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EXAMINER

BACKER, FIRMIN

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/845,611	Applicant(s) KASSAN ET AL.	
	Examiner Firmin Backer	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Arguments***

1. In view of the appeal brief filed on February 3<sup>rd</sup>, 2005, PROSECUTION IS HEREBY REOPENED. An new action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frison et al (U.S. Patent No. 6,049,789) in view of Guheen et al (U.S. PG Pub No. 2004/0107125).

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4. As per claim 1, Frison et al teach a job accounting and chargeback system (*billing system, 308*) for software products (*applications subject to licensing, 210*), the system comprising: a manager (*license management system, 300*) comprising a job accounting and chargeback (JACS) subsystem that develops chargeback data that is referenced to charged entities that are separate of and unrelated to the software product licensors and to the specified license fees- and said job accounting and chargeback system allocates the specified license fees in accordance with predefined criteria based on the charged entities utilization for use of software or computer facilities; and a job accounting and software use intercoupling facility that intercouple the software product use information with the chargeback data in a manner that provides software-product chargeback information (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*). Frison et al fail to teach a software product use monitoring subsystem that handles requests for and grants rights to use software products the use of which requires payment of specified license fees to one or more software product licensors the software license manager further operable to develop and which develops software product use information. However, Guheen et al teach an inventive concept of a software product use monitoring subsystem that handles requests for and grants rights to use software products the use of which requires payment of specified license fees to one or more software product licensors the software license manager further operable to develop and which develops software product use information (*see paragraphs 2324, 2391, 2759, 2860*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Frison to include Guheen et al's inventive concept of a software product use monitoring subsystem that handles requests for and grants rights to use software products the use of which requires payment

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of specified license fees to one or more software product licensors the software license manager further operable to develop and which develops software product use information because this would have provided a license management to ensures that software licenses are being maintained throughout the distributed system and that license agreements are not being violated.

5. As per claims 2, 5, 6, 13 and 14, Frison et al teach a system further including a process-data collector that develops process-related data and the job accounting and chargeback subsystem deriving identities of the charged entities from the process-related data comprises process detail records and links to event log records, including a process-to-product vendor link table (*see fig 1, 2, 3-5*).

6. As per claim 3, Frison et al teach a system in which the software-product chargeback information comprises cost information for the use of the software products and the manager is a license manager (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*)

7. As per claim 4, Frison et al teach a system in which the software-product chargeback information is referenced to software product vendors (*see fig 1, 2, 3-5*).

8. As per claims 5, 7-10, Frison et al teach a system in which the software-product chargeback information comprises process-product-link records and each such record comprises at least two fields include a key field pointing to a process detail record and product key field

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comprises a vendor id or a product id, comprising a third field, which is a link to a particular licensing session (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

9. As per claim 11, Frison et al teach a system further including a plurality of software clients operable with corresponding client exit routines, components of the job accounting and chargeback subsystem being present in the client exit routines (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

10. As per claim 12, Frison et al teach a system in which the process-related data comprises system management facility (SMF) records (*see fig 1, 2, 3-5*).

11. As per claim 15, Frison et al teach a system in which the intercoupling facility correlates the software-product chargeback information to specific product licensing sessions (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

12. As per claim 16, Frison et al teach a system including a facility that develops the software-product chargeback information over selected time periods (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

13. As per claim 17, Frison et al teach a system including a facility that compares chargeback data against budgeted charges relative to specific software products (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

14. As per claims 18 and 19, Frison et al teach a system including a reporter that generates viewable reports including a data sorter, displaying selected portions of the software-product chargeback information (*see fig 1, 2, 3-5*).

15. As per claim 20, Frison et al teach a system including a facility that allocates to specific products a total cost, which cost is used by the job accounting and chargeback subsystem to develop the chargeback data (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

16. As per claim 21, Frison et al teach a system including a facility that measures a parameter indicative of the extent of use of different ones of the software products and the parameter being selected from the parameter group consisting of CPU time; elapsed time; number of queries to a database; number of records retrieved; and use peripherals related to the use of software products (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

17. As per claim 22, Frison et al teach a system in which the software products act in the system as software clients and the manager is a license manager that acts in the system as a server and including a plurality of license manager agents that execute client exit routines in response to being presented with license requests from the software clients, and further including a JACS client exit routine that interacts with the client exit routine of the license manager agents, in a manner such that the JACS client exit routine obtains the process-related data which is then

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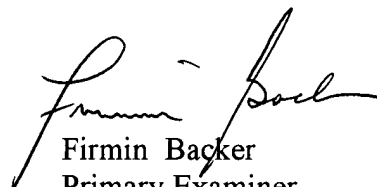
returned to the client exit routine (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Firmin Backer  
Primary Examiner  
Art Unit 3621

April 17, 2005